

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Attorney Docket No. 006401.00371)

In re U.S. Patent Application of)
Wang et al.)
Application No.: 09/863,928)
Appeal No. 2008-4344) Group Art Unit: 1732
Filed: May 23, 2001) Examiner: Monica A. Huson
For: COLD WATER SOLUBLE) Confirmation No. 1613
EXTRUDED STARCH PRODUCT)
)

Commissioner of Patents
P.O. Box 1450
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SUBMISSION OF SUPPLEMENTAL AUTHORITY
APPEAL NO. 2008-4344

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Since the completion of briefing on this Appeal, the office has decided *Ex parte Whalen II*, Appeal 2007-4423 (July 23, 2008). This decision confirmed the holding in *KSR Int'l Co. v. Teleflex Inc.*, 125. Ct. 1727, 1741 (2007) that an invention "composed of several elements is not proved obvious merely by demonstrating that each of its elements was known in the prior art." The *Whalen II* decision contains language especially applicable here. When the prior art "teaches away from the claimed [invention]," obviousness is particularly difficult to demonstrate. The Board held that "it must be shown that those of ordinary skill in the art would have had some reason to modify the known [prior art] in a way that it would result in the claimed [invention]."

Here, the Examiner's attempt to combine Nakatsuka and Redding Jr. is exactly what is proscribed by the *KSR* case and by the *Whalen II* decision. The Examiner purportedly (and mistakenly) finds the elements of the claimed invention independently in the prior art, but even if the Examiner were correct, this would be insufficient to establish obviousness. The Nakatsuka and Redding, Jr. references strongly teach away from one another. Nakatsuka teaches to modify starch very substantially, while Redding, Jr. cautions against modifying starch. Likewise, the Altieri reference teaches directly away from the claimed invention vis-à-vis particle size.

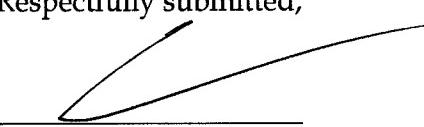
The Examiner *acknowledges* that she is picking and choosing details from the Redding, Jr. and Altieri references while ignoring the overall incompatibility of these references with Nakatsuka and with the claimed invention. Her approach is incorrect as a matter of law. Under *Whalen II*, the Examiner has not "shown those of ordinary skill in the art would have had some apparent reason to modify" the prior art in the manner attempted by the Examiner.

For these reasons, the Board is urged to reverse the Examiner.

Date: August 19, 2008

By:

Respectfully submitted,


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